

REMARKS

This is a full and timely response to the non-final Official Action mailed **May 20, 2009** (the “Office Action” or “Action”). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

Claims 2-4, 6 and 12-27 were cancelled previously without prejudice or disclaimer. No changes to the claims are proposed by the present paper. No claims are added or cancelled by the present paper. Thus, claims 1, 5, 7-11 and 28-34 are currently pending for further action.

35 U.S.C. § 112:

Claims 1 and 28 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. According to the Action,

the specification states the demultiplexer 103 is used to send a received video signal to a hard disk drive 107, a MPEG 2 decoder 104, or both (page 8, ¶ 43-46). However, the specification fails to clearly define how the demultiplexer 103 is used to separate signals from the received multiplexed signals (i.e., a video signal and an audio signal or a video and data signal) as is known in the art. One skilled in the art would assume from reading the specification and reviewing figure 2 that the claimed demultiplexer acts as a switch as it appears the demultiplexer is outputting the exact same video signal to both the hard disk drive and the MPEG 2 decoder.
(Action, p. 3).

Applicant respectfully submits that this rejection is entirely misplaced and should be reconsidered and withdrawn.

If, as the Office Action contends, the multiplexer claimed is merely a “switch,” then one of skill in the art should have no trouble practicing the claimed subject matter. It is unreasonable to reject claims 1 and 28 because one of skill in the art is not “enabled” to

provide a “switch” as the Action construes the claims. Thus, if the Action has correctly construed the claims, a rejection under § 112, first paragraph, for lack of enablement is clearly in appropriate.

However, it is not true that “[o]ne skilled in the art would assume from reading the specification and reviewing figure 2 that the claimed demultiplexer acts as a switch.” (*Id.*). The term “demultiplexer” is widely known in this and other arts and is not synonymous with the term “switch.”

A demultiplexer is generally defined in a variety of arts as “an electronic device that separates a multiplex signal into its component parts.” (<http://www.merriam-webster.com/dictionary/demultiplexer>). It is surprising that the Office Action is either overlooking or ignoring what a demultiplexer actually is.

Moreover, the Action is apparently unaware of the particular function demultiplexers perform in the field of digital video signal transmission. One of skill in the relevant art would know that, in the field of digital video, the term “demultiplexer” is a recognized term of art that refers specifically to a device that separates different digital services that are multiplexed into a single signal, for example, a DOCSIS data stream and digital video data stream. (*See, e.g.,* U.S. Patent App. Pub. No. 20090007211, which describes “a demultiplexer for splitting the video content signal and the data content signal.” (abstract)). This is entirely consistent with the general definition of what a demultiplexer is and does.

Thus, one of skill in the art who understands the use of a demultiplexer in the field of digital video would understand that the claimed demultiplexer actually performs a “demultiplexing” function and is not a mere switch or router as erroneously alleged in the current Office Action.

With regard to the current rejection under §112, first paragraph, Applicant wishes to refer to the following legal standards. It is generally well settled that to comply with the enablement clause of the first paragraph of 35 USC 112, the disclosure must provide an adequate description such that the artisan could practice the claimed invention without undue experimentation. *See In re Scarbrough*, 500 F.2d 560, 182 USPQ 298 (CCPA 1974); *In re Brandstadter*, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973). "A patent need not teach, and preferably omits, what is well known in the art." *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1536, 3 USPQ2d 1737, 1745 (Fed. Cir. 1987).

The burden is initially upon the examiner to establish a reasonable basis for questioning the sufficiency of the disclosure. *In re Strahilevitz*, 668 F. 2d 1229, 212 USPQ 561 (CCPA 1982).

In the present case, the Office Action provides no reasonable basis for questioning the sufficiency of the disclosure. As demonstrated herein, one of skill in the art would know what a demultiplexer does and what a demux specifically is used for in the field of digital video. Consequently, one of skill in the art would be enabled to practice the invention as claimed without any undue experimentation. There is no reasonable basis on the record for questioning that Applicant's claims are enabled by Applicant's specification *to one of ordinary skill in the art*.

The Action's attempt to redefined the claimed "demultiplexer" as a mere switch is both grossly inaccurate in the relevant art and unfair to the Applicant. For all these reasons, the rejection of claims 1 and 28 based on 35 U.S.C. § 112, first paragraph, should be reconsidered and withdrawn.

Prior Art:

Claim 1, 5, 7-11 and 28-34 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Applicant's Fig. 1 ("Allegedly Admitted Prior Art") and U.S. Patent No. 6,233,389 to Barton et al. ("Barton"). For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 1:

Claim 1 recites:

A television signal processing and recording system for handling both digital and analog video signals, said system comprising:
an analog signal path comprising an analog tuner, a video decoder for converting an analog signal to a digital signal, and an encoder for compressing said digital signal output by said video decoder; and
a digital signal path comprising a digital tuner and a demultiplexer;
a connection for routing said compressed digital signal from said encoder of said analog signal path to said demultiplexer;
wherein said demultiplexer outputs a demultiplexed signal to either a decoder with output to a display device or a digital data storage device.
(Emphasis added).

It should be noted that claim 1 recites both an analog and digital signal path and a *demultiplexer* that is part of a digital signal path but also has a connection to the encoder of the analog signal path. The definition and function of the claimed demultiplexer, as it would be understood by one of skill in the art from reading Applicant's specification, has been established above. This subject matter is entirely outside the scope and content of the cited prior art.

The Action concedes that the AAPA does not teach or suggest the claimed connection between an analog signal path and a demultiplexer in a digital signal path. (Action, p. 4). However, the Action argues that Barton teaches the claimed connection, "i.e., the connection

between input section 101 and media switch 102) for rounding said compressed digital signal from said encoder [703] of said analog signal path [102/701].” (Action, p. 5).

This argument is entirely based on the misunderstanding, addressed above, that the claimed demultiplexer is no more than a switch. When one properly construes the term “demultiplexer” as would one of skill in the art, it becomes inescapable that Barton does not teach or suggest a demultiplexer. Rather, as cited in the Action, Barton merely teaches a “media switch” (102/701). Thus, Barton only becomes relevant to Applicant’s claims if, as the Action attempts, one inappropriately redefines the term “demultiplexer” to mean switch.

Consequently, if we use the perspective of one skilled in the art, who knows what a demultiplexer is, as we are required to do, Barton is entirely inapplicable to the claimed subject matter. Barton does not teach or suggest the claimed demultiplexer and, therefore, cannot teach or suggest, in combination with the AAPA, the claimed connection between an analog signal path and such a demultiplexer. In other words, neither the AAPA nor Barton, taken alone or in any combination, teach or suggest the claimed “connection for routing said compressed digital signal from said encoder of said analog signal path to said demultiplexer.” (Claim 1). This subject matter is entirely beyond the scope and content of the cited prior art.

The Supreme Court recently addressed the issue of obviousness in *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007). The Court stated that the *Graham v. John Deere Co. of Kansas City*, 383, U.S. 1 (1966), factors still control an obviousness inquiry. Under the analysis required by *Graham* to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the Office Action has failed to accurately assess the differences between the cited prior art and the

claimed subject matter because the Action has refused to apply the correct definition and understanding to the term “demultiplexer.”

Thus, the scope and content of the prior art, as evidenced by the AAPA and Barton, did not include the claimed subject matter, particularly “a connection for routing said compressed digital signal from said encoder of said analog signal path to said demultiplexer; wherein said demultiplexer outputs a demultiplexed signal to either a decoder with output to a display device or a digital data storage device.” The differences between the cited prior art and the claimed subject matter are significant because the claimed subject matter provides features and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 1 and its respective dependent claims under 35 U.S.C. § 103 and *Graham*.

Claim 28:

Claim 28 recites:

A method for handling both digital and analog video signals, said method comprising:

processing analog signals, when input, in an analog signal path comprising an analog tuner, a video decoder for converting an analog signal to a digital signal, and an encoder for compressing said digital signal output by said video decoder;

processing digital signals, when input, in a digital signal path comprising a digital tuner and a demultiplexer;

routing said compressed digital signal from said encoder of said analog signal path to said demultiplexer; and,

with said demultiplexer, selectively outputting a signal to either a decoder with output to a display device or a digital data storage device.

(Emphasis added).

As demonstrated above, the AAPA and Barton do not, taken together, teach or suggest a method including “routing said compressed digital signal from said encoder of said analog signal path to said demultiplexer.” Neither of the references teaches or suggests a connection

between an encoder in an analog signal path and a demultiplexer in a digital signal path. Consequently, the combination of references does not teach or suggest the claimed “routing said compressed digital signal from said encoder of said analog signal path to said demultiplexer.”

Again, under the analysis required by *Graham* to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art.

In the present case, the scope and content of the prior art, as evidenced by the AAPA and Barton, did not include the claimed subject matter, particularly “a connection for routing said compressed digital signal from said encoder of said analog signal path to said demultiplexer; wherein said demultiplexer outputs a demultiplexed signal to either a decoder with output to a display device or a digital data storage device.”

The differences between the cited prior art and the claimed subject matter are significant because the claimed subject matter provides features and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 28 and its respective dependent claims under 35 U.S.C. § 103 and *Graham*

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner may seek to rely on Official Notice, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

If any fees are owed in connection with this paper that have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC.

Respectfully submitted,

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